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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,803	06/13/2005	Yoshitaka Sakaue	2005_0966A	8801
52349 7590 08/12/2009 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503			EXAMINER VERDERAME, ANNA L.	
			ART UNIT	PAPER NUMBER
			1795	
			MAIL DATE	DELIVERY MODE
			08/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/538,803

Applicant(s)

SAKAUE ET AL.

Examiner

ANNA L. VERDERAME

Art Unit

1795

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 August 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-11.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Mark F. Huff/
Supervisory Patent Examiner, Art Unit 1795

/Anna L. Verderame/
Examiner, Art Unit 1795

Continuation of 11, does NOT place the application in condition for allowance because: The applicant states that the examiner agreed that the prior art rejection of claim 1 was improper. This is incorrect. The examiner did not state her belief that the presence of a second substrate is inherent based on the fact that discs sold commercially have a resin or plastic portion on both sides of the disc. All elements recited in the claims are present in the applicant references.

As stated in the interview summary:

With reference to claim 1, the examiner pointed out the similarity between applicant's figure 1 and Uno et al. figure 1. In figure 8 of Uno the light incidence plane is labeled and in applicant's figure 1 it is the position of the examiner that the light enters the disc through layer 8 based on the placement of the reflective layer. As light enters the disc of figure 1 (applicant) and figure 8 (Uno et al) it passes through a dielectric/protective layer 102, 7 a recording layer 104, 6, a second dielectric/protective layer 5, 106, a reflective layer 107, 4 and a transmittance adjustment layer made of TiO₂ 108, 3. The examiner points out that in applicant's figure 1 the layer 8 is not described in the specification. Based on her knowledge the examiner would expect layer 8 to be a second substrate or a protective layer made from a UV-curing resin. Also, the examiner notes that the disc of figure 8 of Uno et al. will likely have a second substrate of a protective layer formed on the reflective layer 207. Discs sold commercially have a resin or plastic portion on both sides of the disc (emphasis added).

The examiner's claim that a disc will have a resin protective layer or a plastic substrate present on both sides is supported by an example in concurrently applied reference Ishimaru et al. in example 5 where a polycarbonate disc and a UV cured resin layer are present on opposite sides of the disc (0068 and 0073).

It is further the position of the examiner that the order in which the layers are formed, i.e. first to last or last to first, does not matter as long as the final ordering of the layers is that which is desired. As shown above light passing through the disc of Uno et al. passes through the same layer as light passing through the applicant's disc.

Applicant argues the combination of Ishimaru et al. and Uno et al. Applicant states that the properties considered when choosing a separating layer will be different than those when choosing a protective layer. The applicant specifically mentions that the separating layer should have a low optical absorbance. It is the position of the examiner that one of ordinary skill in the art would also want to use a material having a low optical absorbance for the first protective layer. The first protective layer will be located on the light incident side of the recording layer. If the first dielectric layer has a high optical absorbance light will not be efficiently conveyed to the first recording layer. Therefore applicant has not shown that considerations for a separating layer will be different than those for a protective layer. Further, Uno et al. specifically discloses that dielectric materials are suitable for the separating layer. All the materials in question are dielectric materials.

With respect to the unexpected benefits claimed to result when Nb₂O₅ is formed on the substrate, the examiner notes that Nb₂O₅ is not formed directly on the substrate in any of the applicant's examples (emphasis added).